



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,218	08/19/2003	David Blankley	P/131-1	6467

7590
Philip M. Weiss, Esq.
Weiss & Weiss
Suite 251
300 Old Country Road
Mincola, NY 11501

07/18/2008

EXAMINER

COPPOLA, JACOB C

ART UNIT	PAPER NUMBER
----------	--------------

3621

MAIL DATE	DELIVERY MODE
-----------	---------------

07/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/644,218		BLANKLEY, DAVID	
	Examiner		Art Unit	
	JACOB C. COPPOLA		3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is in reply to the remarks filed on 19 May 2008.
2. Claims 1-24 are currently pending and have been examined.
3. All references to the capitalized versions of "Applicants" refer specifically to the Applicants of record. Any references to lower case versions of "applicant" or "applicants" refer to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally. The notations in this paragraph apply to this Office Action and any future office action(s) as well.
4. This Office Action is given Paper No. 20080702. This Paper No. is for reference purposes only.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-24 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

- a. **As per claims 1-10**, based on Supreme Court precedent¹ and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing².

In this particular case, the method steps are not tied to another statutory class. For example, the first step recites “connecting an author to a content repository”, but fails to identify a class of invention that performs the “connecting”. Therefore, the claimed method is not a patent eligible process under § 101.

- b. **As per claims 11-24**, the system of claim 11, and all dependent claims thereof, are directed to a network-based system. “System” is commonly used to denote a machine. Here, the claim is not directed to a machine, but rather to a program or code. Network-based applications, programs and code are not statutory subject matter. Alternatively, processes and “computer-executable programs tangibly embodied on a computer readable medium” may be considered statutory subject matter under 35 U.S.C. §101.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances; *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972)

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-24 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

c. **As per claim 1**, this claim recites “sending content from said author to said content repository” and then “downloading said content from said author to said collaborator”. This claim is indefinite because one of ordinary skill in this art would not understand how the content could be obtained from the author by the collaborator if the author has already sent the content to the repository.

Additionally, this claim recites “aggregate content”. This claim is indefinite because one of ordinary skill in this art could not determine the metes and bounds of the claim term “aggregate content”.

d. **As per claim 11**, this claim recites “a data base which allows an author to upload content”. This claim is indefinite because one of ordinary skill in the art would not understand how a “data base” could give an author this ability.

e. **As per claim 13**, this claim recites “said reuse methodology describes...” This claim is indefinite because the claim to which it depends, namely claim 11, only claims “reuse methodology” in the alternative. Therefore, one of ordinary

Art Unit: 3621

skill in this art would not understand the scope of claim 13 if “reuse methodology” were not used in claim 11.

f. **As per claim 15**, this claim recites “said work”. This term lacks antecedent basis in the claim.

9. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 11-23, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by Stefik et al. (U.S. 5,715,403 A) (“Stefik”).

12. **As per claims 11 and 12**, Stefik discloses the following limitations:

g. *a data base which allows an author to upload content* (“A repository is comprised of..., an external interface for receiving and transmitting data”), (see Figure 1 and associated text);

h. *said system organizing said content by author, title of content, description of content or reuse methodology* (see column 11, lines 25+);

i. *said system comprising information to contact said author* ("author name") (see table 1 and associated text).

13. **As per claim 13**, Stefik discloses the limitations of claim 11, as described above.

Stefik, further, discloses the limitations:

j. *wherein said reuse methodology describes how content can be used and fees entailed* ("usage rights and any associated fees") (see column 6, lines 30+).

14. **As per claim 14**, Stefik discloses the limitations of claim 11, as described above.

Stefik, further, discloses the limitations:

k. *wherein said fee is selected from a flat fee, royalty from direct user, royalty from final end work creator or combination thereof* ("associated fees"), (see column 6, lines 30+).

15. **As per claims 15 and 16**, Stefik discloses the limitations of claim 14, as

described above. Stefik, further, discloses the limitations:

l. *wherein a user can aggregate works from different authors, view said aggregate work and integrate said work to create a derivative work* ("the requester uses the process to change the contents of the digital work as desired... combine it with other information... taking whatever other steps are useful in creating a derivative work"), (see column 41, lines 1+);

m. *wherein said derivative work is put into said system which can be used as a further derivative work* (see column 41, lines 1+).

Art Unit: 3621

16. **As per claim 17**, Stefik discloses the limitations of claim 11, as described above.

Stefik, further, discloses the limitations:

n. *wherein said system provides logical rules on how to use said content*
("rules concerning access rights") (see at least abstract).

17. **As per claim 18**, Stefik discloses the limitations of claim 11, as described above.

Stefik, further, discloses the limitations:

o. *wherein said system provides said author rules to use for said content and*
said author chooses said rules and sends said rules back to said system (see
figure 15, associated text, and column 6, lines 31+).

18. **As per claim 19**, Stefik discloses the limitations of claim 18, as described above.

Stefik, further, discloses the limitations:

p. *wherein said rules includes fees ("associated fees"), (see column 6, lines*
31+).

19. **As per claim 20**, Stefik discloses the limitations of claim 11, as described above.

Stefik, further, discloses the limitations:

q. *wherein said system determines content contributors ("creator") and*
royalty allocations ("associated fees"), (see column 6, lines 31+).

20. **As per claim 21**, Stefik discloses the limitations of claim 11, as described above.

Stefik, further, discloses the limitations:

r. *wherein said system informs said authors of use of said content*
(inherently done by author receiving fees), (see column 23, lines 50+).

21. **As per claim 22**, Stefik discloses the limitations of claim 11, as described above.

Stefik, further, discloses the limitations:

s. *wherein said system logs activity of users and determines royalty allocation for said authors* (see column 23, lines 50+).

22. **As per claim 23**, Stefik discloses the limitations of claim 11, as described above.

Stefik, further, discloses the limitations:

t. *wherein said system bills users periodically* ("the billing module may... periodically communicate billing data to a central billing facility, whereupon the user may be billed"), (see column 3, lines 20+).

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 1-10, 16, and 24, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Stefik et al. (U.S. 5,715,403 A) ("Stefik"), in view of Schneck et al. (U.S. 2003/0163428 A1) ("Schneck").

25. **As per claim 1**, Stefik discloses *a method for creating derivative works* (see column 40, line 53, through column 41, line 44). Additionally, Stefik discloses the following limitations:

Art Unit: 3621

- u. *connecting an author to a content repository* (see figure 1 and associated text);
- v. *sending meta data from said author to said content repository* (see figure 1, table 1, and associated text);
- w. *sending content from said author to said content repository* (see figure 1 and associated text);
- x. *connecting a final uploader to said content repository* (see figure 1 and associated text);
- y. *uploading aggregate content and meta data from said final uploader to said content repository* (see figure 1 and associated text).

Stefik does not specifically disclose the following limitations:

- z. *connecting a collaborator to said content repository; and downloading said content from said author to said collaborator from said content repository.*

Schneck, however, does disclose the following limitations:

- aa. *connecting a collaborator to said content repository* (see figure 15 and associated text);
- bb. *downloading said content from said author to said collaborator from said content repository* (see figure 15 and associated text);

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the system of Stefik the collaborator as

Art Unit: 3621

taught by Schneck since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

26. **As per claim 2**, Stefik/Schneck discloses the limitations of claim 1, as described above. Stefik/Schneck, further, discloses the limitations:

cc. *determining content contributors ("creator") and royalty allocations ("associated fees")*, (see Stefik: column 6, lines 62+).

27. **As per claim 3**, Stefik/Schneck discloses the limitations of claim 1, as described above. Stefik/Schneck, further, discloses the limitations:

dd. *notifying all contributors regarding use of said content ("the server generates a transaction identifier that is used in records or reports of the transaction")*, (see Stefik: column 31, lines 6+).

28. **As per claim 4**, Stefik/Schneck discloses the limitations of claim 1, as described above. Stefik/Schneck, further, discloses the limitations:

ee. *tracking what content a user accesses ("the display/execution repository **411** is further coupled to a credit server **414** to report any fees to be billed for access to a digital work")*, (see figure 4b and associated text).

29. **As per claim 5**, Stefik/Schneck discloses the limitations of claim 1, as described above. Stefik/Schneck, further, discloses the limitations:

ff. *collecting subscription fees for said author from a user and logging activity of said user to determine royalty allocation* (see Stefik: column 23, lines 50+).

Art Unit: 3621

30. **As per claim 6**, Stefik/Schneck discloses the limitations of claim 2, as described above. Stefik/Schneck, further, discloses the limitations:

gg. *billing all users on a periodic basis based on use* (“the billing module may... periodically communicate billing data to a central billing facility, whereupon the user may be billed”), (see Stefik: column 3, lines 25+).

31. **As per claim 7**, Stefik/Schneck discloses the limitations of claim 2, as described above. Stefik/Schneck, further, discloses the limitations:

hh. *determining periodically royalties owed to each author and disbursing funds*, (see Stefik: column 3, lines 25+).

32. **As per claim 8**, Stefik/Schneck discloses the limitations of claim 2, as described above. Stefik/Schneck, further, discloses the limitations:

ii. *calculating said royalties based on usage of each authors works* (“usage rights and any associated fees assigned by a creator”), (see Stefik: column 6, lines 31+).

33. **As per claim 9**, Stefik/Schneck discloses the limitations of claim 2, as described above. Stefik/Schneck, further, discloses the limitations:

jj. *determining an algorithm to allocate royalties* (“algorithm”), (see Stefik: column 46, lines 1+).

34. **As per claim 10**, Stefik/Schneck discloses the limitations of claim 9, as described above. Stefik/Schneck, further, discloses the limitations:

kk. *wherein said algorithm varies based on type of content being sold* (see Stefik: column 46, lines 1+).

Art Unit: 3621

35. **As per Claim 24**, Stefik discloses the limitations of claim 11, as described above.

Stefik does not specifically disclose the following limitations:

ll. *wherein said system checks for duplicate content, if duplicate content is found said system does not post said duplicate content.*

Schneck, however, does disclose the limitations:

mm. *wherein said system checks for duplicate content, if duplicate content is found said system does not post said duplicate content (see table 1, and associated text).*

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the system of Stefik the integrity check as taught by Schneck since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

36. Claims 15 and 16, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (U.S. 5,715,403 A) ("Stefik"), in view of Schneck et al. (U.S. 2003/0163428 A1) ("Schneck").

37. **As per Claim 15**, Stefik discloses the limitations of claim 14, as described above.

Stefik, further, discloses the limitations:

nn. *wherein a user can aggregate works from different authors, and integrate said work to create a derivative work ("the requester uses the process to change*

the contents of the digital work as desired... combine it with other information... taking whatever other steps are useful in creating a derivative work"), (see column 41, lines 1+).

Stefik does not specifically disclose the following limitations; however Schneck does disclose the limitations:

oo. *view said aggregate work* (see ¶ 0130).

Therefore, if not anticipated by Stefik, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the system of Stefik the ability to view the aggregate work as taught by Schneck since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

38. **As per claim 16**, Stefik discloses the limitations of claim 15, as described above.

Stefik, further, is believed to anticipate the following limitations:

pp. *wherein said derivative work is put into said system which can be used as a further derivative work.*

However, if Stefik does not anticipate, then Schenk does teach the following limitations:

qq. *wherein said derivative work is put into said system which can be used as a further derivative work* (see figure 15, associated text, and ¶ 0269: "n-th generation derivative work").

Therefore, if not anticipated by Stefik, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the system of Stefik the ability to put the derivative work into system for further use as taught by Schneck since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

39. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

40. Using the broadest reasonable interpretation, the following definitions are relied upon by the Examiner when interpreting claim language:

rr. **metadata** or **meta data** "1. Data about data. For example, the title, subject, author, and size of a file constitute metadata about the file." (Computer Dictionary, 5th Edition, Microsoft Press, Redmond, WA, 2002)

ss. **database** "A file composed of records, each containing fields together with a set of operations for searching, sorting, recombining, and other functions." Id.

Art Unit: 3621

41. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see e.g. "User Level Beginning..."), because of the references' basic content (which is self-evident upon examination of the references), and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within theses references.

Conclusion

42. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Jacob C Coppola/
Examiner, Art Unit 3621
July 2, 2008

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621